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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,218	01/18/2001	Markus Haller	P-9417	7371
27581	7590	03/27/2006	EXAMINER	
MEDTRONIC, INC. 710 MEDTRONIC PARK MINNEAPOLIS, MN 55432-9924			PRIETO, BEATRIZ	
			ART UNIT	PAPER NUMBER
			2142	
DATE MAILED: 03/27/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/765,218

Applicant(s)

HALLER ET AL.

Examiner

Prieto B.

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/22/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32, 34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 32, 34 and 35 is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to Amendment After-final filed February 22, 2006, claims 1-11, 13-15, 16-29, 31 and 33 have been canceled. Amendment after-final also added new claims 34-35, which seem to be the corresponding apparatus and method claims to claim 32 has been indicated on final office action mailed 12/22/05 as being allowable.

2. Double Patenting Rejection issues with respect to US 6,804,558 issued Sept. 5, 2002.

Finality of previous office action is hereby withdrawn. Prosecution is reopened for the purposes of making the below rejection of record. Claims 32, 34-35 are in condition of allowance.

3. Claim 34 is objected to due to the following minor informality: step or act (a) has a double preposition, i.e. "for" and further "mobile telephone" seems to subsequently be referred to as "mobile phone". Correction is required.

Double Patenting Rejection

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would

have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 35, 34 and 32 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of US 6,804,558 (referred to as patent '558 hereafter). Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons set below.

Claim 35, 34 and 32 are rejected on the ground of nonstatutory double patenting over at least claim 1 of (US 6,804,558) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

6. Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970). The portions of the patent disclosure pertain to the invention claimed in the

patent have been considered. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Regarding at least claim 35, Haller teaches, a method comprising:

generating an invoice for the provision of medical services relating to communicating information between an implantable medical device (IMD) implanted in a patient and a remote computer system (column 35, lines 48-67, column 36, lines 18-25 and/or column 38, lines 4-30);

said method utilizing a system for at least one of monitoring the performance of the IMD, monitoring the health of the patient and remotely delivering a therapy to the patient through the IMD, wherein said IMD is capable of bi-directional communication with a communication module located external to the patient's body (abstract), wherein said system further comprises:

the IMD; the communication module; and a mobile telephone capable of being operably connected to the communication module and capable of receiving information therefrom or relaying information thereto (abstract, and/or column 1, lines 40-45);

means for generating an invoice in response to information relating to the IMD being relayed or transmitted from or to the mobile phone (claim 1, column 35, lines 48-67, column 36, lines 18-25 and/or column 38, lines 4-30),

a communication system capable of bi-directional communication with the mobile telephone and a remote computer system (abstract), said method further comprising:

(a) operating the IMD to determine whether medical attention should be provided and (b) in response to the determination made in step (a), uploading data from the IMD to the communication module (claim 1 of patent '558, namely requesting...uploading.. column 32, line 40-54);

(c) transferring the data from the communication module to the mobile telephone and thence on to the remote computer system via the communication system for (d) remotely analyzing the data (claim 1

of patent '558, namely, analyzing by the remote system, namely, column 32/line 55 to column 33, line 32);

(e) determining on the basis of the analyzed data whether remedial action respecting at least one of the IMD and the patient is required and (f) remotely executing the determined remedial action via the communication system (claim 1 of patent '558, namely, diagnosing...executing and confirming, column 32, line 40 to column 33, line 32) and

(g) automatically generating an invoice in response to at least one of steps (a), (b), (c), (d), (e) and (f) being carried out (claim 1 of '558 invoice generation by provider for medical response, described on column 34, lines 18-26, column 35, lines 19-34, & 47-67, column 36, lines 18-25, and/or column 38, lines 4-30), however does not disclose the detection of a component or software defect within the IMD or the remote computer system, and broadcasting an alert if a remote repair is available

Thus, the limitations of instant application, namely, generating an invoice..., monitoring the health of a patient..., remotely delivering a therapy..., a mobile telephone connected to a communication module..., a communication system capable of bi-directional...uploading data..., transferring from communication module to mobile telephone to remote computer system...analyzing data from the IMD to determine a remedial action and executing it...and generating invoice in response...are substantially the same as claim 1 of the '558 patent and/or portions of the patent disclosure pertaining the claimed patent limitations, namely, establishing communication...requesting medical services..., uploading data..., analyzing data... diagnosing the patient...determining and executing remedial response...confirming remedial response... and generating invoice..., noted above.

Hence, [AS BEST UNDERSTOOD] (a) the scope of the claims of instant application, namely, remotely delivering therapy to a patient through the IMD using a system including a communication module and a mobile telephone for sending data from the IMD to a remote computer system, and the scope and corresponding content of a '558 patent with respect to at least claim 1, namely, for remotely delivering patient request medical services to an IMD over a communication system, contain substantially

the same limitations and/or were described subject matter of said patent in the pertinent portions; (b) the difference noted between the scope and content of the patent claim, is namely, the detection of a component or software defect within the IMD or the remote computer system, and broadcasting an alert if a remote repair is available. This difference in scope is minor and patentably indistinct between the claims being compared because the addition of the limitation, steps or act of detecting and repairing a defect in the system or the IMD, does not change the overall inventive concept claimed and/or described by corresponding supportive disclosure.

Patent protection for the invention, fully disclosed in and covered by the claim of the reference, would be extended by the allowance of the claim in the later filed application.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (571) 272-3902. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Andrew T. Caldwell can be reached at (571) 272-3868. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free).

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B. Prieto
Primary Examiner
TC 2100
March 20, 2006

Beatriz Prieto
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